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Paper No. 6

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MAR 29 2002

In re Application of
Craig Rae Fowler et al
Application No. 09/833,165
Filed: April 11, 2001
Attorney Docket No. 60,130-788

OFFICE OF PETITIONS

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:
: DECISION REFUSING 37 CFR
: 1.47(a) STATUS
:

This is in response to the petition under 37 CFR 1.47(a), filed April 11, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item. (1) set forth above.

As to item (1), the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate inventor Barry, such that the declaration can be accepted under 37 CFR 1.47(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted.

In the instant case, petitioner states that several attempts were made to contact nonsigning inventor Barry at his address and that letters and copies of the application were sent to Mr. Barry on June 26, 2000 and October 18, 2000. Petitioner has not indicated what attempts were made to reach nonsigning inventor Barry, only that "several attempts were made," nor has petitioner submitted copies of the correspondence mailed to Mr. Barry indicating what was actually mailed or as to whether these mailings ever reached the intended addressee. Since it is presumed that the correspondence was returned as undeliverable, petitioner must state what attempts were made to locate the inventor after the mailing of the letters and copies of application sent to Mr. Barry on June 26, 2000 and October 18, 2000. At the very least, a search should be made of the telephone directories and any regional or national registry(s). Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d).

Additionally, petitioner should state what inspection of the assignee's personnel records reveals as to a current address, forwarding address, or an address of the nearest living relative. What does inspection of the phone directories for those address locations reveal? Has any of inventor Barry's former co-workers kept in touch with him? Has petitioner attempted to locate inventor Barry on the Internet? If so, what were the results of the Internet search? If inventor Barry is located, then a complete copy of the application papers (specification, claims, drawings, oath, etc.) should be mailed to Mr. Barry's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that inventor Barry cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

If inventor Barry is located and the inventor orally refuses to join in the application, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of Wan Laymon.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
Mail Stop DAC
P.O. Box 2327
Arlington, VA 22202

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Wan Laymon at (703) 306-5685.



Frances Hicks
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for Patent Examination Policy